

**REMARKS**

Claims 1-16 are pending. Reconsideration and allowance of the pending claims are respectfully requested in light of the following remarks.

**Rejections under 35 U.S.C. §102(e)**

Claims 1-6 and 8-10 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,027,414 to Walsh et al. (hereinafter “Walsh”). Applicants respectfully traverse the Examiner’s position for the following reasons.

First and foremost, Walsh does not qualify as prior art under 35 U.S.C. § 102(e) *vis-a-vis* the pending claims. In this regard, Applicants refer the Examiner to the Declaration under 37 C.F.R. §1.131 (“Rule 1.131 Declaration”) enclosed herewith, which establishes that Applicants conceived of the claimed invention prior to August 9, 2001, the priority date of Walsh, and exercised due diligence from prior to that date until the filing of the present application. As such, Walsh cannot be relied upon to sustain the rejection of claims 1-6 and 8-10; therefore, Applicants respectfully request that the rejection be withdrawn.

Even assuming *arguendo* that Walsh is available as prior art, the rejection should be withdrawn for the following additional reasons. In particular, the PTO provides in MPEP § 2131 that

*"[t]o anticipate a claim, the reference must teach every element of the claim..."*

With regard to independent claims 1 and 6, Applicants maintain their position previously set forth that Walsh fails to teach every element of those claims. In particular, with regard to claim 1, Walsh fails to teach or suggest a step of “applying a service marking to the packet dependent on the application associated with the packet”. On the contrary, as noted by the Examiner, Walsh discloses that “classification logic 208, as in step 405, classifies the packets to a transport service.” Col. 10, lines 51-52 (emphasis added). Clearly, this is not equivalent to “applying a service marking to the packet” as required by claim 1.

With regard to claim 6, Walsh fails to teach or suggest “a table comprising an index including at least one key, each key having a record associated therewith, each record having a service marking therein, the node operable to interrogate the table with an identification of an application obtained from the packet, the service marking returned to the node upon a match between the identification and one of the keys.” Contrary to the Examiner’s assertion, Walsh’s teaching of queues that affect mapping of transport services to packet delivery services does not anticipate the above-noted element as recited in claim 6. Clearly, Walsh fails to teach “the node operable to interrogate the table with an identification of an application

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**RESPONSE UNDER 37 C.F.R. §1.116**

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obtained from the packet, the service marking returned to the node upon a match between the identification and one of the keys” as required by claim 6. Indeed, the Examiner fails to point to any element of Walsh that he believes to anticipate the claimed “the node operable to interrogate the table with an identification of an application obtained from the packet.”

In view of the foregoing, it is apparent that the rejection of independent claims 1 and 6 under 35 U.S.C. §102(e) is not supported by Walsh and should therefore be withdrawn. Claims 2-5 and 8-10 depend from and further limit independent claims 1 and 6 and are therefore also deemed to be in condition for allowance.

**Rejections under 35 U.S.C. §103(a)**

Claims 7 and 11-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Walsh in view of U.S. Patent No. 7,023,820 to Chaskar (hereinfter “Chaskar”). Applicants traverse this rejection on the grounds that the above references are defective in establishing a prima facie case of obviousness with respect to the noted claims.

In particular, claims 7 and 11 depend from and further limit claims 1 and 6 and are therefore allowable for at least the reasons described in the preceding section. Additionally, Chaskar, which is cited as teaching an access router (claim 7) and a GPRS support node (claim 11), fails to remedy the deficiencies of Walsh discussed above in connection with claims 1 and 6.

With regard to claims 12-16, as previously noted, Walsh does not qualify as prior art *vis-a-vis* the pending claims, as demonstrated by the enclosed Rule 1.131 Declaration. As such, Walsh cannot be relied upon to sustain the rejection of claims 12-16 and Applicants therefore respectfully request withdrawal of the rejection.

In addition, even assuming *arguendo* that Walsh is available as prior art, Applicants traverse the rejection on the grounds that this combination of references is defective in establishing a prima facie case of obviousness with respect to claims 12-16.

In *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), the Court stated that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed

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discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741 (emphasis added).

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

MPEP § 2143.03 states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In the present case, the Examiner has not shown that all words in the claims have been considered. In particular, with regard to claim 12, Walsh fails to teach or suggest a service node that is operable to interrogate a table with a query value indicative of an application to obtain a service marking therefrom for the reasons set forth above with respect to claim 6. Walsh further fails to teach or suggest a service node that is operable “to write the service marking into a field of the packet, the node operable to transmit the packet across the telecommunication network” for the reasons set forth above with respect to claim 1. Chaskar, which is cited for its teaching of BSS 118, fails to remedy the limitations of Walsh discussed above.

Thus, for each of these reasons, the Examiner’s burden of factually supporting a prima facie case of obviousness clearly cannot be met, and the rejection of claim 12 under 35 U.S.C. §103 should be withdrawn. Claims 13-16 depend from and further limit claim 12 and are therefore also deemed to be in condition for allowance for at least the same reasons as claim 12.

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**Conclusion**

It is clear from all of the foregoing that claims 1, 6, and 12 are in condition for allowance. Claims 2-5, 7-11, and 13-16 depend from and further limit independent claims 1, 6, and 12 and are therefore also deemed to be in condition for allowance.

An early formal notice of allowance of claims 1-16 is therefore respectfully requested.

Should the Examiner deem that an interview with Applicants' undersigned attorney would expedite consideration of the claims, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



Brandi W. Sarfatis

Registration No. 37,713

Dated: 12/3/07  
HAYNES AND BOONE, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 214/651-5896  
Facsimile: 214/200-0948

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Ellen Lovelace